UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/082,601 | 02/22/2002 | Satoshi Nakajima | 109908-130337 | 5731 |

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| EXAMINER |
|---|
| DOAN, DUYEN MY |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2152 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/082,601 | NAKAJIMA, SATOSHI |
| | Examiner | Art Unit | |
| | DUYEN M. DOAN | 2152 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on <u>27 May 2008</u>.

2a)☒ This action is **FINAL**.  2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) <u>7-12,14-20,27-31 and 33-40</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>7-12,14-20,27-31 and 33-40</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 February 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

## DETAILED ACTION

*This office action is in response to the submission filed on 5/27/2008. Claims 7-12,14-20,27-31 and 33-40 are amended for examination.*

### Response to Arguments

In response to applicant's argument regarding to the 112 1st rejections, the argument is persuasive, therefore the rejections are withdrawn.

Applicant's arguments filed 5/27/2008 in regarding to 103(a) rejections have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art does not teach, "one or more transition rules specifying one or more transitions to one or more user interface displays enter a particular user interface display state" examiner respectfully disagrees, the transition rules is inherently existed with each application in Shaffer, to enable the system to display the files based on the type of the file, for example, the Microsoft word document will be displayed in a particular way, on the other hand, the excel document or a PDF document will be displayed in another ways.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 7-12, *14-15, 18-20, 27-31 and 33-35, 38-40* are rejected under 35

U.S.C. 103(a) as being unpatentable over Martin et al (us pat 6,272,484) (hereinafter

Martin) in view of Shaffer et al (us 2002/0059347) (hereinafter Shaffer).

As regarding claim 7, Martin discloses process by the computing device the

binary file (the binary file is an inherent feature since all of the files, does not matter

what source application uses to create the file, when process by the computer, the

computer will process the file in binary form) to generating by the computing device a

self-contained representation of user interface displays of said binary file rendered when

content of the binary file are viewed using the source application, by associating results

of said processing of said binary file with the selected set of user interface display

specification (see Martin col.9, lines 62-67 to col.10, lines 1-10, also see figure 6, the

self-contained package 623 including the file itself and the viewer code (viewer code

corresponds to the graphical representations)), to enable viewing of the user interface

displays independently of the source application (see Martin col.11, lines 47-51, user

can view the self-contain without any additional software).

Martin does not clearly teach identifying by a computing device a format of a

binary file generated by a source application; selecting a set of user interface display

specifications from a plurality of sets of interface display specifications, based at leas in

part on the identified format of the binary file; each transition rule specifies transition to another user interface display specified by another specification when the user interface displays enter a particular user interface display state.

Shaffer teaches identifying by a computing device a format of a binary file generated by a source application (see Shaffer pg.2, par 0025, the binary file is inherently process by the computer, the computer analyzing the file to identify the format of the file); selecting a set of user interface display specifications from a plurality of sets of interface display specifications, based at leas in part on the identified format of the binary file (see Shaffer pg.2, par 0025, after analyzing the format of the file, compare it to store table of application suffixes, for example, .doc file may be associate with a Microsoft word, .PDF file may be associated with an Adobe Acrobat Reader); each transition rule specifies transition to another user interface display specified by another specification when the user interface displays enter a particular user interface display state (see Shaffer pg.2, par 0025, the transition rules is inherently existed with each application, to enable the system to display the files based on the type of the file, for example, the Microsoft word document will be displayed in a particular way, on the other hand, the excel document or a PDF document will be displayed in another ways).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Shaffer to the method of Martin to identify the format of the binary file and selecting the representations of the binary file for the purpose of enhancing the email process (see Shaffer pg.1, par 0007).

As regarding claim 8, Martin-Shaffer discloses attaching by the computing device said self-contained representation with an electronic message (see Martin col.9, lines 33-36, electronically email the self-contain representation); and transmitting by the computing device said electronic message and said attached self-contained representation to one or more recipients for viewing, where the viewing includes rendering said user interface displays in accordance with said user interface display specifications and user input(s) (see Martin col.9, lines 21-39).

As regarding claim 9, Martin-Shaffer discloses binary file is either a word processing document or a spreadsheet document (see Martin col.10, lines 36-42).

As regarding claim 10, Martin-Shaffer discloses determining is based upon a filename extension associated with said binary file (see Shaffer pg.2, par 0025, file suffixes, .DOC, .PDF).  The same motivation was utilize in claim 7 applied equally well to claim 10.

As regarding claim 11, Martin-Shaffer discloses launching by the computing device a locally accessible version of the application (see Shaffer pg.2, par 0025); simulating by the computing device user input(s) to said application based at least in part upon said selected set of user interface display specifications (see Shaffer pg.2, par 0025); and storing by the computing device output(s) from said application in

response to said user input(s) (see Shaffer pg.2, par 0025). The same motivation was

utilize in claim 7 applied equally well to claim 11.


As regarding claim 12, Martin-Shaffer teaches each specification includes one or

more transition rules specifying one or more transitions to one or more other user

interface displays specified by one or more other specifications (see Martin col.10, lines

43-55).


As regarding claim 14, Martin-Shaffer teaches each of said user interface

displays comprises one or more display cells, and each of said specification comprises

one or more display cell specifications correspondingly specifying the one or more

display cells (see Martin col.10, lines 43-55).


As regarding claim 15, claim 15 contains limitations that are similar to the

limitations of the rejected claim 1, Martin-Shaffer further discloses receiving, by a

computing device, an email message including an associated first attachment of a first

attachment type (see Martin pg.2, par 0025, receive the attachment, determine the

format of the attachment); determining, by the computing device, whether said first

attachment type is associated with a member of a group of one or more supported

source applications (see Martin pg.2, par 0025, compare the file extension with the table

of applications); selecting, by the computing device, a set of one or more user interface

display specifications from a plurality of sets of one or more user interface display

specifications, based upon said first attachment type if it is determined said first

attachment type is associated with a member of said group of one or more supported

source applications (see Martin pg.2, par 0025, select the application if the match

found); launching, by the computing device, a locally accessible version of the

associated source application (see Martin pg.2-3, par 0025); simulating, by the

computing device, one or more user input signals based upon said selected set of one

or more user interface display specifications (see Martin pg.2-3, par 0025).  The same

motivation was utilized in claim 7 applied equally well to claim 15.


    As regarding claim 18, Martin-Shaffer discloses a proprietary format (see Martin

col.10, lines 34-42).


    As regarding claim 19, Martin-Shaffer discloses each of said plurality of user

interface displays comprises one or more display cells, and each of said user interface

display specifications comprises one or more display cell specifications (see Martin

col.10, lines 43-55).


    As regarding claim 20, Cook discloses each of said user interface displays

comprises one or more display cells, and each of said specification comprises one or

more display cell specifications correspondingly specifying the one or more display cells

(see Martin col.10, lines 43-55).

As regarding claims 27-31,33-35, 38-40, the limitations of claims 27-35, 38-40 are similar to the rejected claims 7-15, 18-20 therefore rejected for the same rationales.

Claims 16-17,36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin-Shaffer as applied to claims 15,35 above and further in view of what was well known in the art.

As regarding claims 16-17, 36-37 Martin-Shaffer discloses the invention substantially as claim in claims 15,35 above, Martin-Shaffer does not explicitly disclose encoding the attachment, wherein encoding that message using MIME protocol, transmit the encoded message and the attachment to the recipient.

Official Notice is taken (see MPEP 2144.03) concept of encoding that message using MIME protocol, and transmitting the encoded message and the attachment is well known at the time the invention was made.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of what was well known in the art to the method of Martin-Shaffer to encode the message and send the message with the attachment to recipient for the purpose of allowing quickly deliver the content message.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action.  In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the

examiner should be directed to DUYEN M. DOAN whose telephone number is

(571)272-4226.  The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913.  The fax

phone number for the organization where this application or proceeding is assigned is

571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. M. D./
Examiner, Art Unit 2152

/Bunjob  Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152